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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		471842001600	
	Application Number	Filed	
	10/022,058	December 13, 2001	
	First Named Inventor Mingxian HUANG et al.		
	Art Unit	Examiner	
	1641	A. Lam	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,422</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature Michael G. Smith Typed or printed name (858) 720-5113 Telephone number December 14, 2006 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 798280831 US, on the date shown below in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: December 14, 2006

Signature:  (Grace Yu)

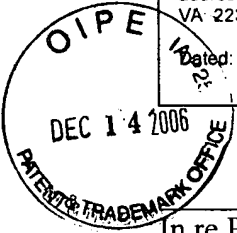
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Dated: 12/14/06

Signature: \_\_\_\_\_

(Grace Yu)

Docket No.: 471842001600  
(PATENT)



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Mingxian HUANG et al.

Application No.: 10/022,058

Confirmation No.: 5669

Filed: December 13, 2001

Art Unit: 1641

For: ACTIVE AND BIOCOMPATIBLE  
PLATFORMS PREPARED BY  
POLYMERIZATION OF SURFACE COATING  
FILMS

Examiner: A. Lam

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In further response to the final Office Action dated June 14, 2006, and the Advisory Action dated November 17, 2006, applicants submit a Pre-Appeal Brief Request for Review. A Notice of Appeal is filed herewith, along with a three-months extension of time, thereby extending the deadline for response to December 14, 2006. Accordingly, this request is timely filed.

**Remarks/Arguments** begin on page 2 of this paper.

### **REMARKS**

The Examiner combined a disclosure of a device in Pourahmadi (U.S. 6,440,725) with a material from a second reference, Burdon (U.S. 6,572,830) in the only outstanding rejection of the claims, which is based on 35 U.S.C. § 103. Pourahmadi teaches a device that can be made of various materials, including glass or plastic. The Examiner said it would be advantageous to modify Pourahmadi to provide 'optical access' into the device, and selected a reference to combine with Pourahmadi that allegedly renders obvious the claimed invention.

There is No Need to Modify Pourahmadi: However, *no modification of Pourahmadi is needed* to provide 'optical access' into Pourahmadi's device. Pourahmadi says glass or plastic can be used to make its device: conventional glass is transparent and thus achieves the result the Examiner says is desirable. The person of ordinary skill would undoubtedly have used conventional glass or plastic, consistent with the disclosure in Pourahmadi, if motivated to achieve 'optical access'. The Examiner has shown NO reason one would have needed to 'modify' Pourahmadi or combine it with any other reference to achieve that effect. This combination of references is improper, and this rejection should be withdrawn.

The Burdon Reference Was Selected Based on the Applicant's Disclosure: In order to reject the claims, the Examiner selected a specific material from a second reference, Burdon, to use in combination with Pourahmadi's teachings. Burdon discloses a material referred to as green-sheet, which is a composite material and may include a variety of components. Some versions "may include glass particles, so as to provide an optically transmissive layer allowing external optical access." Col. 3, lines 48-50. The Examiner combined this green-sheet material with Pourahmadi to provide 'optical access', i.e., green-sheet was used solely because it can be made transparent. According to the Examiner, in order to 'provide optical access', the person of ordinary skill would have been motivated to select the *specific* material in Burdon from among *all possible transparent materials*, avoiding conventional glass as disclosed in Pourahmadi. That reasoning is the epitome of hindsight. The Examiner ignored the express disclosure of 'glass' and identified a specific material in Burdon, which could only have been identified by searching for materials based

on the applicant's claims. The Examiner has identified no advantage of this specific material over conventional glass or plastic materials that can be transparent, and has offered no reason why a person of ordinary skill would have selected the 'specific' material instead of, e.g., glass. This rejection is based on improper hindsight, using the applicant's disclosure, and should be withdrawn.

In the advisory action maintaining the obviousness rejection, the Examiner said this: "Pourahmadi teaches that any suitable substrate materials may be used, including glass, and Burdon teaches a particular type of glass substrate, i.e., one made of glass particles. The motivation to utilize the particular material for a substrate as taught by Burdon, as opposed to other materials that may be used, such as those listed by Pourahmadi, is that it allows for external optical access. Moreover, because Pourahmadi only teaches glass substrates in general and Burdon teaches a particular type of glass substrate, it would have been obvious to one of ordinary skill in the art to utilize the specific type of glass substrate taught by Burdon as the glass substrate generally taught by Pourahmadi."

The Examiner's own statements here clearly illustrate that a hindsight analysis was used. The Examiner selected "the specific type of glass substrate taught by Burdon" without explaining why plain glass, as suggested by Pourahmadi, would not have been suitable. The fact that green-sheet "allows for external optical access" is merely an after-the-fact rationalization for selecting "the specific type of glass": green-sheet offers no apparent advantage over common, conventional materials—including glass, as disclosed by Pourahmadi. Again, Pourahmadi discloses the use of glass or plastic, which would equally well "allow[] for external optical access." The "specific type of glass substrate" in Burdon is not needed, nor is it better than glass. It was selected by the Examiner based on the applicant's disclosure, not based on its inherent advantages. At most, it is 'obvious to try', in the sense that the person of ordinary skill might eventually have used it if he chose to systematically try all possible transparent materials—but he would not have had motivation to select the material in Burdon over plain glass, for example. The rejection relies upon impermissible hindsight and should be withdrawn.

Burdon's Material is Neither Advantageous over Nor Equivalent to Ordinary Glass: The MPEP says substituting a new material for one described in a primary reference in order to establish an obviousness rejection is only proper where the new material is an 'art recognized' equivalent of the one in the primary reference. "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents." MPEP 2144.06, citing *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Merely sharing one property, transparency, with the glass named in Pourahmadi, or even being a "functional or mechanical equivalent" to it is not enough to render the combination obvious.

Moreover, Burdon states that "In certain applications it also [sic: may be] desirable to add glass coatings to the surfaces of green-sheet layers. For example, glass coatings provide smooth walls in fluid passageways, thereby providing better fluid flow and reducing contamination problems. Glass coatings can also serve as barriers between the fluid and green-sheet materials that may be reactive or otherwise incompatible with the fluid." Burdon at col. 9, lines 1-7. Thus Burdon teaches that its green-sheet material is not 'equivalent' to glass: in fact, it is inferior to glass in applications such as that of Pourahmadi since Burdon says that glass provides 'better fluid flow' and 'reduc[es] contamination problems.'

The Examiner has not offered any evidence to suggest that Burdon's green-sheet is 'equivalent' to glass for the purpose of the present claims, or that it was recognized in the art as such. In view of the comments in Burdon indicating that glass may be better than green-sheet in fluid-handling systems such as that in Pourahmadi, one of ordinary skill would have been motivated not to use green-sheet instead of conventional glass in Pourahmadi's device.

The rejection is clearly inconsistent with the MPEP and with the case law. The combination it relies upon is not *prima facie* obvious because: (a) the person of ordinary skill would not have needed to modify Pourahmadi to use a transparent material, since it discloses one; (b) the person of ordinary skill would have had no reason to select the specific green-sheet material from Burdon, from among all possible transparent materials; (c) the green-sheet material in Burdon

is not an art-recognized equivalent of glass, and (d) there is evidence that the green-sheet material from Burdon is inferior to glass in applications such as the device in Pourahmadi, so there is reason *not* to use Burdon's green-sheet material. Burdon teaches applying a layer of glass *over* green-sheet to solve problems that may be encountered with green-sheet in fluid-handling devices; thus there is not even a reasonable expectation that using green-sheet would work as well as a conventional glass or plastic material. Therefore, the person of ordinary skill would not have chosen to make Pourahmadi's device using green-sheet, and this rejection should be withdrawn.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 471842001600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: December 14, 2006

Respectfully submitted,

By   
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